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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,032	09/20/2001	Alan J. Lang	D-2821CON	6533
33357	7590	02/28/2006	EXAMINER	
ADVANCED MEDICAL OPTICS, INC.			CHATTOPADHYAY, URMİ	
1700 E. ST. ANDREW PLACE			ART UNIT	
SANTA ANA, CA 92705			PAPER NUMBER	

3738

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/960,032

Applicant(s)

LANG, ALAN J.

Examiner

Urmi Chattopadhyay

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/30/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 70-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed November 30, 2005 has been entered. The change to claim 84 has been approved by the examiner. All pending claims 70-88 are being considered for further examination on the merits.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 70-73, 75-81 and 85-88 are rejected under 35 U.S.C. 102(b) as being anticipated by Portney (USPN 5,702,440, as cited in applicant's IDS).

Portney discloses an intraocular lens with all the elements of claims 70 and 81. See Figures 2 and 3 for a single, unitary multifocal lens body (11) sized and adapted for placement in the mammalian eye, and having a central zone (18) with a baseline optical power providing a mean power for distant vision (column 2, lines 39-43) and a plurality of annular regions (19, 20, 21, 22) each having an optical power. See Figure 4 of Portney as being comparable to Figure 3 of applicant for the plurality of annular regions including a region having a first/maximum optical add power for near vision, and a second/additional optical add power intermediate between the first optical add power and the baseline optical add power. See column 4, lines 31-34 for the diopter correction provided being varied with the prescription needs of the patient.

Art Unit: 3738

Because the diopter correction will vary with the amount of accommodative capability of the natural lens, Portney is clearly suggesting that the IOL be used in an eye including a natural lens having at least some natural accommodative capability. Accordingly, the first/maximum optical add power will have a magnitude so as to provide, in combination with the natural accommodative capability of the natural lens of the eye, enhanced reading vision ability. Each of the optical add powers will also be less than the full optical power required for near reading in a pseudophakic subject.

Claim 71, see Figure 2 for a fixation member (15) coupled to the lens body (11).

Claim 72, see Figure 4 for each annular region having a different optical add power.

Claim 73, see rejection to claim 81, supra.

Claims 75 and 85, see Figure 4 for the lens body (11) not including cylinder correction.

Claims 76-79, 86 and 87 are intended use claims. See Figure 2 for the lens body (11) and fixation member (15) being structurally capable of being placed in the anterior or posterior chamber of the eye.

Claims 80 and 88, see column 3, lines 24-26 for the lens body (11) being deformable for insertion through a small incision into the eye.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 74 and 82-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portney in view of Menezes et al. (USPN 5,847,802, as cited in applicant's IDS).

Portney discloses an intraocular lens with all the elements of claims 70 and 81, including that the diopter correction will vary depending on the needs of the individual patient, but is silent to the first/maximum optical add power being reduced by at least 10%, 20% and 50% relative to the optical add power required for near reading in a subject not having a natural lens in place, as required by claims 74 and 82-84. Menezes et al. teaches that for an IOL, "(s)ome patients may not require the full...add powers in these designs. For these cases, the...near powers can be made a fraction (preferably 50%) of the full...add power". See column 4, line 52-55. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to look to the teachings of Menezes et al. to modify the IOL of Portney by having the first/maximum optical add power reduced by at least 50%, which is at least 10% and 20%, in order to meet the needs of the patient when full optical add power is not required.

Response to Arguments

6. Applicant's arguments filed November 30, 2005 have been fully considered but they are not persuasive. In response to applicant's argument that the IOL of Portney is suited to a patient having minimal residual accommodation as opposed to a patient having natural accommodative capabilities (as required by applicant), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. First, a natural lens with

Art Unit: 3738

“minimal residual accommodation” still has some, though very little, accommodative capability. Portney does not say the IOL is suited only to a patient with no accommodation. Second, because claims 70 and 81 are product claims, it is not required that Portney teach varying a diopter correction based on the amount of accommodative capability of the natural lens. Because Portney teaches that the diopter powers shown in Fig. 4 are merely exemplary, and the actual correction provided will vary with the prescription needs of the patient, Portney is clearly suggesting an embodiment wherein the IOL has annular near zones 19, 20 that form plateaus 41, 45 at less than approximately 3.5 diopter power. That IOL would meet the structural limitations of claims 70 and 81, and certainly would be capable of performing the intended use of providing enhanced reading vision ability if implanted in a mammalian eye including a natural lens having natural accommodative capability. Again, because the independent claims of the application are product claims, it is not required that the prior art teach the product being used in the same manner as claimed. It is only required that the prior art product be capable of being used in the same manner. Because Portney does not specifically teach away from the IOL being used in an eye having accommodation, and the IOL of Portney would not be destroyed or become non-functional if used in the manner claimed by applicant, the limitations of claims are met.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

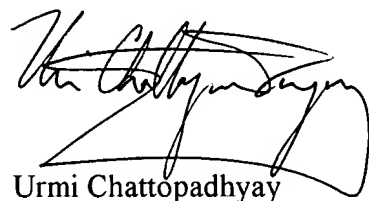
Art Unit: 3738

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urmi Chattopadhyay whose telephone number is (571) 272-4748. The examiner can normally be reached Monday through Thursday and every other Friday from 9:00am to 6:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached at (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Urmi Chattopadhyay

Art Unit 3738



David J. Isabella
Primary Examiner